

## REMARKS

Claims 1-19 are pending in the Application. Of the claims remaining in the case, claims 1, 12, 13, 16, 17, 18 and 19 are independent claims. Claims 1-3, 5-10, and 12-19 stand rejected under 35 U.S.C. § 102(b) as being “anticipated by applicant admitted prior art Figure 5 and as disclosed in the specification on pages 12 and 13,” claims 1-10 and 12-19 stand rejected under 35 U.S.C. § 102(a) as being “anticipated by My Great Home®,” and claims 4 and 11 stand rejected under 35 U.S.C. § 103(a) as being “unpatentable over [either] Applicant admitted prior art [or My Great Home®] in view of USG.com (sheetrock brand joint compound).”

For the reasons set forth below, Applicant respectfully traverses these rejections, and reexamination and reconsideration of the Application are respectfully requested. Specifically, while these rejections were continued from the Examiner’s first Office Action dated August 7, 2006, and made “Final” in the instant Office Action, based on the Interview conducted on March 15, 2007, and the Examiner’s concession that the prior art of record, including Applicant-admitted prior art Figure 5 and the My Great Home® reference, does not disclose a drywall joint as now more expressly claimed wherein a flexible layer of tape or caulk forms the center-line surface of the joint rather than chalky joint cement, Applicant contends that substantial new issues related to patentability have been raised that warrant continued examination of the case without a formal Request for Continued Examination and fee under 37 C.F.R. § 1.114; namely, that the current after-Final Amendment is made in good faith following the March 15<sup>th</sup> Interview and concession of the Examiner that certain of the claims are or would be allowable over the prior art of record and, as such, that the Action being made “Final” was, in a sense, premature.

Specifically, then, Applicant respectfully contends that this Amendment should be duly entered and responded to as being in compliance with 37 C.F.R. § 1.116(b)(3).

The various refusals are now addressed below in more detail in connection with the amended claims and the discussions had during the recent Telephonic Interview. For simplicity, Applicant has focused the present responsive Amendment on those specific issues raised in the Interview, though all other arguments for allowance of the claims as previously presented are incorporated herein by reference to the extent that they are consistent with the current amendments and arguments.

**35 U.S.C. §§ 102(a) and 102(b) Rejections**

Claims 1-3, 5-10, and 12-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Figure 5 and the content of pages 12 and 13 of Applicant's specification, and claims 1-10 and 12-19 stand rejected under 35 U.S.C. § 102(a) as being "anticipated by My Great Home®."

Turning first to the claim rejections under Section 102(b) based on the Applicant-admitted prior art shown and described in Figure 5 and on pages 12 and 13 of the Specification, as Applicant explained during the Interview, what is shown and described as prior art by Applicant's own admission is utterly distinct from the claimed invention. As stated in the pages cited by the Examiner:

The conventional joint construction 110, as shown in Figure 5, includes abutting drywall boards 120, 130 having tapered first and second lengthwise edges 122,

132 so as to form a channel 140 that is partially filled in by a first taping coat 152.

A drywall tape 160 is applied over the taping coat 152, and then *the joint is flushed by one or more topping coats 170 of joint cement over the tape 160*. Thus, it is clear that in the typical prior art drywall joint, joint cement forms the center-line surface 180 directly over the channel 140. See page 12, line 26 – page 13, line 3 (emphasis added).

In contrast to the above-described prior art joint construction, in Applicant's joint construction, "a flexible layer 60, preferably of either tape or a flexible compound such as caulk, forms the center-line surface 80." See page 9, lines 18-20. As pointed out during the Interview, the "center-line surface" as recited in the claims is expressly supported by and defined in the Specification at page 10, lines 8-11. Accordingly, as emphasized during the Interview, this center-line surface, or the exposed surface of the drywall joint directly over the lengthwise crack 40 formed between abutting edges 22, 32 of adjacent drywall boards 20, 30, is stronger and less prone to cracking by eliminating the conventional weak and chalky joint cement in this surface area, which is all that is shown in the prior art, and replacing the joint cement with a flexible material such as tape or a compound such as caulk.

As the Examiner indicated during the Interview, with reference to claim 1, because in the Specification the recited "flexible layer" *may* be a tape or a flexible compound but does not necessarily have to be, causing claim 1 as originally written to read more broadly, Applicant has amended claim 1 to make clear that this flexible layer is to be either tape or caulk, written in Markush format. Thus, claim 1 now effectively recites that the center-line surface of the drywall

joint be formed by tape or caulk. Because the Examiner further indicated that when such additional detail is recited the claim would then not read on any prior art of record, Applicant respectfully contends that claim 1 as now written is allowable.

Independent claims 12 and 13 were similarly amended to make clear that tape forms the center-line surface of the drywall joint, which structure is once again not taught or suggested by the prior art. Once more, the My Great Home® reference clearly discloses that even in a non-tapered, or non-recessed, drywall board joint, the tape is pressed into a first layer of joint compound or mud and then “cover[ed] with another thick layer of compound.” Again, then, as emphasized during the Interview, the prior art actually teaches away from Applicant’s claimed invention by only suggesting that the flexible tape be buried beneath joint cement rather than ever having the tape form the center-line surface of the finished joint.

Accordingly, since claim 1 as now written has been shown to be allowable over the prior art of record, it follows that claims 2-11 that depend therefrom are also allowable. Similarly, claims 14 and 15 that depend from independent claim 13 are also allowable on this basis.

Turning to claim 16, similar to the concern regarding “flexible layer” in claim 1, during the Interview the Examiner expressed a concern regarding the language “flexible compound” as originally recited in claim 16 and elsewhere. Support for this language is again found in the Specification at page 9, lines 18-20, where it is stated that “a flexible compound such as caulk” may form the center-line surface of the joint. However, once more, the Examiner has taken the position that while the flexible compound *may* be caulk, it does not literally have to be, leaving

the claim over-broad. Accordingly, to better clarify this limitation, the term “flexible compound” has been replaced with “caulk” throughout the claims. As such, claim 16, for example, is now allowable over the prior art of record as reciting a caulk filling the crack between abutting drywall boards so as to form the critical center-line surface and flush the joint. Because the prior art simply makes no such disclosure of such a flexible caulk layer forming the center-line surface, Applicant respectfully urges that claim 16 is allowable as amended.

Thus, in connection with both the Section 102(a) and Section 102(b) rejections, as distinct from the conventional drywall joint construction shown and described by Applicant in connection with prior art Figure 5 and as further disclosed in the My Great Home® and Sheetrock® references, Applicant’s joint construction in at least three variations essentially entails the absence of conventional joint cement at the center-line surface of the joint and the absence of tape buried within the joint underneath joint cement of any kind, and instead the use of a flexible material or compound such as tape or caulk at the center-line surface. In this way, it will be appreciated that the drywall joint is finished much more quickly than in the conventional method with less materials and time, or labor costs, required. And the resulting joint, though relatively quicker and easier to finish, has also shown to be stronger and less prone to surface cracking (see page 13, line 7 – page 14, line 25).

With this understanding of the differences between the identified prior art and Applicant’s invention, it is abundantly clear that the subject matter of independent claims 1, 12, 13, 16, 17, 18 and 19 is allowable over the art of record. Again, as the Examiner noted in the first Interview Summary, Applicant has employed the relatively closed transitional phrase

“consisting essentially of,” rather than the open phrase “comprising,” in all such claims, whether for the joint construction itself or the method of its use, in order to make clear that the entire joint construction or methodology (i.e., all of its constituent parts or steps) is recited and anything not recited is not and cannot be part of the claimed invention, except for those further features “that do not materially affect the basic and novel characteristics” of the claimed invention, as pointed out by the Examiner in the instant Office Action, citing to MPEP § 2111.03 [R3].

As required by Section 2111.03 and the cases cited therein, Applicant has made clear in the Specification and by the claim language that *none* of the claimed joint constructions or methods of use include joint cement forming the center-line surface of the joint or have tape covered by any such joint cement. See page 7, lines 9-12; page 9, lines 11-20; page 10, lines 8-12; page 11, lines 24-27; page 12, lines 16-22; page 14, lines 12-25; and Figures 2-4. Applicant thus contends that any joint construction or methodology that includes joint cement over the flexible layer of tape or caulk, or that has the tape anywhere but at the center-line surface, *does* “materially affect the basic and novel characteristics” of Applicant’s invention for the reasons stated above and so is structure that is excluded from the scope of the claims, even with the “consisting essentially of” transitional phrase. Therefore, any joint construction that has tape buried beneath joint cement, rather than at the center-line surface, is expressly not within the scope of the claims. Or put another way, Applicant’s invention as disclosed and claimed requires that the flexible tape be at the surface of the joint (claims 2, 12 and 13) or not be in the joint at all (claims 10 and 16).

On this further basis, Applicant respectfully contends that the claims are all allowable as written since the prior art of record in *every* instance requires or teaches that joint cement would be positioned at or form the center-line surface of the drywall joint *over* the flexible tape. In fact, once more, the My Great Home® reference cited by the Examiner actually teaches away from Applicant's claimed invention by in every example of "Finishing the Drywall," again, whether with tapered or non-tapered boards, instructing the artisan to apply multiple coats of joint cement (compound or mud) *over* the drywall tape so as to thus form the center-line surface of the joint.

At this juncture it is also appropriate to correct a misstatement in the instant Office Action. The Examiner indicated that "[A]pplicant argues that the prior art of record does not disclose a joint finishing system that includes a 'flexible layer'." However, as was pointed out during the March 15<sup>th</sup> Interview and should be self-evident from the foregoing, Applicant has never taken the position that prior art drywall joints do not include a "flexible layer" (i.e., tape), but instead that no prior art drywall joints known to Applicant or of record have such a flexible layer *forming the center-line surface of the joint* as disclosed and claimed by Applicant. Rather, in the prior art, the tape is always buried beneath the joint cement.

Returning to the use of the "consisting essentially of" transitional phrase in the claims, as pointed out above, Applicant has chosen this language to make clear that certain additional structure and steps, namely, covering the tape with joint cement, are expressly excluded from the claims as materially altering Applicant's invention wherein joint cement is removed from the center-line surface and, where tape is used, it is never buried underneath joint cement of any kind but is always at the center-line surface. Thus, in claim 16, for example, where caulk expressly

forms the center-line surface, by the claim language read in light of the Specification, tape thus cannot also be at the center-line surface, and since tape is not to be anywhere but the center-line surface, or is not to be buried below any kind of top coat, tape is thus excluded from the joint construction of claim 16 altogether by use of the “consisting essentially of” phrase; that is, the use of tape underneath the caulk would materially affect the basic and novel characteristics of the invention.

But by comparison, Applicant has intentionally *not* used the transitional phrase “consisting of” so as to not unnecessarily limit the claims from additional structure that does *not* materially affect the claimed invention. For example, in claim 1, the use of joint cement of any kind *over* the tape is excluded structure, while the use of even a conventional joint cement or a non-shrinking formulation *under* the tape is not excluded structure (see claims 3 and 4, respectively).

### **35 U.S.C. § 103(a) Rejections**

Claims 4 and 11, each further limiting independent claim 1 by reciting that the taping compound or the flexible compound is a non-shrinking formulation, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either the Applicant-admitted prior art or the My Great Home® reference in view of USG.com (Sheetrock® brand joint compound). First, as set forth above, because claim 1 has alone been shown to be allowable as neither anticipated by nor obvious in light of any of the prior art of record, alone or in combination, it follows that claims 4 and 11 that depend therefrom are also allowable on this basis.



Specifically, turning first to claim 4, which depends from claim 1 through claims 2 and 3, it is recited that the “joint cement is a non-shrinking formulation” (claim 4), which joint cement is “the taping compound” (claim 3), which taping compound “fill[s] the channel so as to cover the channel sides” with “a tape forming the flexible layer and covering the taping compound” (claim 2). Thus, what is clearly recited in claim 4 is a non-shrinking compound *beneath* tape that forms the center-line surface of the joint (claims 1 and 2).

Claim 11 was amended as explained above to replace “flexible compound” with “caulk,” thereby more definitely reciting a drywall joint construction not disclosed or even suggested by the prior art of record, wherein caulk fills the crack between abutting drywall boards and forms the center-line surface of the joint without the use of tape or any other joint cement.

In terms of the USG reference, then, Applicant again points out that in the section entitled “Gypsum Panel Joint Treatment” of the “Sheetrock® Brand Setting-Type Joint Compounds” document, USG clearly describes a method of use and resulting joint structure again much like that disclosed by My Great Home®, wherein the joint is covered with “a thin layer of compound” to *embed* the drywall tape, once this has dried, “a second coat” is applied *over* the tape, and once this has dried, “a third coat” is applied over the second coat. Therefore, while the Sheetrock® compound may be relatively non-shrinking in some sense, it is clearly, by USG’s own teaching, not to be applied only underneath the tape, as recited in claim 4, or capable of or designed to be applied in finishing or flushing a joint without the use of any tape, as is Applicant’s caulk both by the literal language of claim 11 and as supported by the Specification. Thus, there is simply no teaching or suggestion to employ the “setting-type joint compounds”

disclosed in the cited Sheetrock® reference in any drywall joint construction disclosed and claimed by Applicant, namely, only underneath the tape (claim 4) or with no tape at all (claim 11).

Based on the foregoing, and the information provided by Applicant during the March 15<sup>th</sup> Interview relating to the commercial response to his invention already received, it is clear that Applicant has made a valuable contribution to the art of drywall joint finishing by providing a system and method effectively antithetical to decades of industry tradition and accepted practices and that actually overcomes deficiencies in those practices and yields a joint construction that is both improved and relatively less costly. It is respectfully submitted, then, subject to further searching that the Examiner may conduct, that claims 1-19 as presently pending all distinguish over the art of record and are in condition for immediate allowance. Prompt and favorable notice thereof is respectfully requested.

**CONCLUSION**

From the foregoing it is apparent that Applicant has made a valuable contribution to the art. All claims now in the case patentably distinguish over the prior art of record and are in condition for allowance. Consequently, early notice of allowance is respectfully solicited. If the Examiner is not in agreement, it is requested that she feel free to telephone the undersigned to discuss any concerns that may remain regarding allowance of the rejected claims.

Respectfully submitted,

MIND LAW FIRM

A handwritten signature in black ink, appearing to read "J V Sartain", with a long horizontal flourish extending to the right.

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